In the Supreme Court of the United States.

OCTOBER TERM, 1903.

THE UNITED STATES EX RELATIONE Charles P. Steinmetz, plaintiff in error,
v.
FREDERICK I. ALLEN, COMMISSIONER of Patents, defendant in error.
No. 383.

BRIEF FOR THE DEFENDANT IN ERROR.

This cause is before the court on a writ of error to the court of appeals of the District of Columbia to review a judgment of that court affirming a judgment of the supreme court of the District dismissing a petition for mandamus directing the Commissioner of Patents to permit an appeal within his Office in a matter arising out of application for a patent.

The application was filed by the plaintiff in error November 21, 1896, and contained seven claims covering an alleged new form of electrical apparatus entitled a motor meter, and also six claims covering a process of actuating motor meters. It was referred to a primary examiner for action, and he directed that it be so divided as to present process and apparatus claims separately, and repeated such ruling. The applicant, alleging

that this was a rejection of his claims, attempted to appeal to the examiners in chief, under the provisions of section 4909, Revised Statutes, which is as follows:

> Every applicant for a patent or for the reissue of a patent, any of the claims of which have been twice rejected, and every party to an interference, may appeal from the decision of the primary examiner, or of the examiner in charge of interferences in such case, to the board of examiners in chief; having once paid the fee for such appeal.

The primary examiner refused to permit the appeal for the reason that he had not rejected any claim, and the Commissioner declined to direct him so to do.

The plaintiff in error then made application to the supreme court of the District of Columbia for a mandamus commanding the Commissioner to direct the primary examiner to permit the appeal and to forward the papers to the examiners in chief.

THE PETITION.

The allegations of the petition (Rec., 1 to 7) were in substance these:

The petitioner filed in the Patent Office a complete application for a patent upon an improvement in motor meters November 21, 1896, of which improvement he was the inventor.

The application contained thirteen claims, the first six covering a process of operating motor

meters, and the last seven the apparatus disclosed therein; it was referred to a primary examiner for action, and on May 15, 1900, he required cancellation therefrom of claims 7 to 13, relating to the apparatus, and upon reconsideration repeated this action July 31, 1900.

Regarding this as final rejection of claims 7 to 13, petitioner August 4, 1900, filed an appeal therefrom to the examiners in chief, which, contrary to his duty, the primary examiner refused to forward with his answer, as required by the Rules of Practice of the Patent Office.

On August 20, 1900, petitioner asked the former Commissioner by interlocutory petition to direct the examiner to forward the appeal. This was denied September 28, 1900.

On January 16, 1902, petitioner asked the present Commissioner to direct the primary examiner to forward the appeal and this was also denied February 7, 1902.

On February 28, 1902, petitioner asked the examiners in chief directly to hear and determine his appeal, notwithstanding the primary examiner's refusal to answer, and this was denied.

Alleging that it was the duty of the primary examiner to forward the appeal to the examiners in chief with answer thereto, and that upon his refusal it was the duty of the Commissioner of Patents to direct him to forward it, petitioner prayed the supreme court of the District that a writ of mandamus be issued to the Commissioner

commanding him to order the primary examiner to forward the appeal to the examiners in chief, with his proper answer, as required by the rules of the Patent Office.

THE RETURN.

The return of the Commissioner (R., 8 to 11) admits the filing of the application and its contents, the allegations as to inventorship, the filing of an appeal to the examiners in chief, and the various steps taken by the petitioner to have the same determined.

It recites further action in the case as follows:

On October 9, 1899, the primary examiner, to whom the case was referred for action, wrote applicant requiring division between his process and apparatus claims, in accordance with rule 41 of the Rules of Practice, before further action would be given upon the merits.

The applicant without then contesting the requirement for division asked, December 15, 1899, that his process claims be placed in interference with claims in a patent to one Duncan, saying:

> It is therefore requested that the requirement for division be waived for the present in order that an interference with the patent to Duncan above referred to may be declared.

The examiner replied, January 2, 1900:

> Pending the determination of the interference, applicant may retain the method and apparatus claims in this case, but the acceptance of an interference on one of the

> method claims will be held by the office to be an election of the prosecution of the method claims, and further prosecution of the apparatus claims in this application will not be permitted.

The applicant acquiesced in this ruling, and wrote January 19, 1900:

> It is respectfully requested that the interference with the Duncan patent, No. 604464, be declared as soon as possible.

The interference with Duncan was then declared, and after a final decision therein in applicant's favor, the examiner wrote him May 15, 1900:

> In accordance with office letter of January 2, 1900, applicant is required to cancel from this case all claims except those for the method.

This action was repeated upon reconsideration, and the examiner refused to permit an appeal to the examiners in chief, on the ground that his action was not a rejection and was not appealable under section 4909, Revised Statutes.

The applicant then, by interlocutory petition, asked the Commissioner to direct the examiner to permit the appeal, and this was denied, Assistant Commissioner Chamberlin saying:

> * * * It has been the practice for the past thirty years to treat the question not as one of merits and appealable to the examiners in chief, but as a proper matter for petition for the Commissioner. I see no reason for overturning this practice.

Acquiescing in this ruling, applicant, by interlocutory petition under rule 145, without fee, asked the Commissioner to review and reverse the examiner's requirement for a division of the application, and the Commissioner, after consideration, was of opinion that the ruling was proper, and sustained the examiner.

On January 16, 1902, applicant, by interlocutory petition, asked the present Commissioner to direct the examiner to permit his appeal to the examiners in chief, and this he refused, saying:

> The requirement for division is clearly a matter of form, not involving the merits of the claims, since the claims may be, and in the present case are, regarded as allowable. The examiner has not refused to grant a patent to this applicant upon any of the claims presented, but has merely required that they be included in two patents instead of one. It is a question of procedure or of the manner of securing the protection which is in controversy, and not the right of the applicant to a patent upon any of the claims presented.

The return denies that the action of the primary examiner was a rejection of any claim, and alleges it was a mere preliminary requirement as to procedure, a matter resting entirely within the discretion of the Commissioner as head of the office and not appealable. It denies the petitioner was entitled to appeal to the examiners in chief, and

that it was the duty of the Commissioner to direct that the appeal be forwarded.

The petitioner moved for a peremptory writ of mandamus, notwithstanding the answer. The District supreme court denied this, and the court of appeals affirmed such action.

The plaintiff's right to a writ of error to this court to review the judgment of the court of appeals is predicated upon the allegation that there is drawn in question the validity of "an authority exercised under the United States."

STATUTES.

Sections 233 and 234 of the act of 1901 (chapter 854, 31 Stats., 1227) are as follows:

> SEC. 233. Any final judgment or decree of the court of appeals may be reexamined and affirmed, reversed, or modified by the Supreme Court of the United States, upon writ of error or appeal, in all cases in which the matter in dispute, exclusive of costs, shall exceed the sum of five thousand dollars, in the same manner and under the same regulations as existed in cases of writs of error on judgments or appeals from decrees rendered in the supreme court of the District of Columbia on February ninth, eighteen hundred and ninety-three, and also in cases, without regard to the sum or value of the matter in dispute, wherein is involved the validity of any patent or copyright, or in which is drawn in question the validity

of a treaty or statute of, or an authority exercised under, the United States.

SEC. 234. In any case heretofore made final in the court of appeals it shall be competent for the Supreme Court of the United States to require, by certiorari or otherwise, any such case to be certified to said Supreme Court for its review and determination, with the same power and authority in the case as if it had been carried by appeal or writ of error to said Supreme Court.

Rules of Patent Office:

An application filed in the Patent Office is first referred to a primary examiner for action; if he twice rejects any claim an appeal may be taken to the examiners in chief (sec. 4909, Rev. Stats.); if they affirm the decision appeal may be taken to the Commissioner (sec. 4910, Rev. Stats.), and if he affirms the decision appeal may be taken to the court of appeals of the District of Columbia (sec. 4911, Rev. Stats., and sec. 9, act of February 9, 1893, R. S. U. S., Sup., vol. 2, c. 74).

The following rules of the Patent Office, made under the authority of section 483, Revised Statutes, bear upon the action taken:

41. Two or more independent inventions can not be claimed in one application; but where several distinct inventions are dependent upon each other, and mutually contribute to produce a single result, they may be claimed in one application.

Claims for a machine and its product must be presented in separate applications.

Claims for a machine and the process in the performance of which the machine is used must be presented in separate applications.

Claims for a process and its product may be presented in the same application.

42. If several inventions, claimed in a single application, be of such a nature that a single patent may not be issued to cover them, the inventor will be required to limit the description, drawing, and claim of the pending application to whichever invention he may elect. The other inventions may be made the subjects of separate applications, which must conform to the rules applicable to original applications. If the independence of the inventions be clear, such limitation will be made before any action upon the merits; otherwise, it may be made at any time before final action thereon, in the discretion of the examiner.

133. Every applicant for a patent, any of the claims of whose application have been twice rejected for the same reasons, upon grounds involving the merits of the invention, such as lack of invention, novelty, or utility * * * may, upon payment of a fee of $10, appeal from the decision of the primary examiner to the examiners in chief. The appeal must set forth in writing the points of the decision upon which it is taken, and must be signed by the applicant or his duly authorized attorney or agent.

145. Upon receiving a petition stating concisely and clearly any proper question

which has been twice acted upon by the examiner, and which does not involve the merits of the invention claimed, or the rejection of a claim, and also stating the facts involved and the point or points to be reviewed, an order will be made fixing a time for hearing such petition by the Commissioner, and directing the examiner to furnish a written statement of the grounds of his decision upon the matters averred in such petition within five days after being notified of the order fixing the day of hearing. The examiner shall at the time of making such statement furnish a copy thereof to the petitioner. No fee is required for such a petition.

The defendant in error contends:

I. This court has no jurisdiction to entertain the writ.

II. The decision of the court of appeals is right, and if the cause is considered here should be affirmed on the merits.

ARGUMENT.

I.

There is not here drawn in question the validity of "an authority exercised under the United States"—the only ground upon which it is alleged this court has jurisdiction.

Plaintiff in error nowhere questions the authority of the Commissioner of Patents to act on his petition, but, on the contrary has, by asking for

such action, admitted the Commissioner's authority to take it. He now says that the decision rendered in response to his request was wrong.

It is well settled by many decisions of this court that the validity of an authority exercised under the United States is not drawn in question simply because the correctness of a decision rendered by one exercising such authority is disputed. The validity of the authority must be called in question, and not merely the rightfulness or wrongfulness of the officer's action.

In the case of *Baltimore and Potomac Railroad Company* v. *Hopkins* (130 U. S., 211–226) suit was brought in the supreme court of the District of Columbia against the railroad to recover for alleged injuries occasioned by unlawful use of streets in Washington, which the railroad claimed to occupy and use as it did under authority of Congress. The court charged the jury that the railroad had a right, under the act of Congress, to use the streets in certain ways, but not in other ways. A writ of error was sued out and it was argued in this court that the validity of an authority exercised under the United States was drawn in question, and this gave jurisdiction. The writ was dismissed. After citing a number of authorities, Mr. Chief Justice Fuller, delivering the opinion, said:

> (P. 226) The validity of the statutes and the validity of authority exercised under them are, in this instance, one and the same

> thing; and "the validity of a statute," as these words are used in this act of Congress, refers to the power of Congress to pass the particular statute at all, and not to mere judicial construction as contradistinguished from a denial of the legislative power. In our opinion the validity of no act of Congress, or authority under the United States, was so drawn in question here as to give us jurisdiction.

In *United States* v. *Lynch* (137 U. S., 280–285), a mandamus proceeding instituted in the supreme court of the District of Columbia, it was claimed that it was the mere ministerial duty of the Auditor under the statute to allow relator's claim for mileage, but that in violation of that duty he undertook to exercise a discretion not possessed and to disallow the same, and that this being an invalid exercise of an authority under the United States the validity of such authority was drawn in question. And upon that ground it was maintained this court had jurisdiction on writ of error. The writ was dismissed. Mr. Chief Justice Fuller, speaking for the court, said:

> (P. 285.) In order to justify this position, however, the validity of the authority must have been drawn in question directly and not incidentally. The validity of a statute is not drawn in question every time rights claimed under such statute are controverted, nor is the validity of an authority, every

time an act done by such authority is disputed. The validity of a statute or the validity of an authority is drawn in question when the existence, or constitutionality, or legality of such statute or authority is denied and the denial forms the subject of direct inquiry.

We think that the authority of the Second Comptroller and the Fourth Auditor is not thus denied here, nor the validity of that authority questioned, but that what is claimed is that in the exercise of a valid authority the Auditor and Comptroller erred in respect to an allowance, in view of the decision of this court in another case. * * *

What the relator sought was an order coercing these officers to proceed in a particular way, and this order the supreme court of the District declined to grant. If we were to reverse that judgment upon the ground urged, it would not be for want of power in the Auditor to audit the account and in the Comptroller to revise and pass upon it, but because those officers had disallowed what they ought to have allowed and erroneously construed what needed no construction. This would not in any degree involve the validity of their authority.

The case of *South Carolina* v. *Seymour* (153 U. S., 353, 360) was before this court on a writ of error to the court of appeals of the District of Columbia, which had denied a writ of mandamus to

the Commissioner of Patents to register a trade-mark. The writ was dismissed for lack of jurisdiction. Mr. Justice Gray delivered the opinion, and said therein—

> In the present case no objection to the validity of the act of Congress under which the Commissioner of Patents acted was made, either at the hearings in the Patent Office and in the courts in the District of Columbia or in the briefs filed by counsel in this court. Nor was the existence or the lawfulness of the authority conferred by that act upon the Commissioner of Patents drawn in question. But from the beginning to the end of the proceedings the only controversy was as to the construction of the act of Congress, and consequently as to the nature and extent of the Commissioner's authority. Neither the question whether the Commissioner rightly decided upon the presumptive lawfulness of the right of the State of South Carolina to the trade-mark sought to be registered, nor the question whether the Commissioner's duty was of such a character that a writ of mandamus would lie to compel its performance, involved a question of the validity of the authority exercised by him under the United States.

In *Linford* v. *Ellison* (155 U. S., 503) it was held that a decision of the supreme court of Utah, adjudging a municipal tax void because not authorized by the organic law, did not involve the

validity of a statute of the United States nor was there drawn in question any authority exercised thereunder.

The question at issue in the present case was whether the Commissioner of Patents was wrong in refusing to direct an appeal from the primary examiner. His authority to act was admitted by asking for a mandamus.

II.

The action of the court of appeals was right on the merits.

The opinion of the court below which appears in the record is an able and complete discussion upon the merits of the questions involved, and is especially commended to the attention of this court as showing beyond question the correctness of its judgment.

The commissioner decided, upon petition to him, the matter which had been ruled upon by the primary examiner. Mandamus will not lie to compel him now to refer it to a lower tribunal in his own office.

It is fundamental that mandamus will not issue against a public officer except to compel the performance of some plain, clear, ministerial duty, and will not issue to control his discretion. (*Decatur* v. *Paulding*, 14 Peters, 515; *Mississippi* v. *Johnson*, 4 Wall., 475; *Redfield* v. *Windom*, 137 U. S., 636; *Dunlap* v. *Black*, 138 U. S., 636.)

Where it is the duty of the officer to pass upon a question, mandamus may be used to compel him

to decide, but not to compel him to decide in any particular way, nor to set aside a ruling already made.

In the present case the Commissioner, upon the request of plaintiff, rendered a decision upon the very question which it is now desired he shall transmit to the examiners in chief in his office for another decision. (Par. 13, return, page 10, record.) In other words, having asked the Commissioner to pass on the question, and not being satisfied with the decision, plaintiff now seeks a mandamus commanding the Commissioner to set that aside and refer the case to a lower tribunal in his office.

When the Commissioner reviewed and sustained the action of the primary examiner requiring division between process and apparatus he performed his full duty under the law. He has not failed or refused to act, but plaintiff wishes a different result.

The Commissioner is the head of the Patent Office, and when he personally acts upon a case he can not be required to refer it to a lower tribunal in his office. This was settled in the case of *Commissioner of Patents* v. *Whiteley* (4 Wall., 522), a proceeding for mandamus commanding the Commissioner to refer Whiteley's application to a primary examiner for consideration and action, after he had taken it up himself and had ruled that Whiteley was not entitled to a reissue. This court held a mandamus did not lie to require him to thereafter refer the case to a lower tribunal. The

court further said that since his ruling went to the merits Whiteley was entitled to appeal therefrom to the court.

In this case, if the examiner's requirement, approved by the Commissioner, is to be regarded as a final rejection, appeal lies to the court of appeals, and not from the primary examiner to the examiners in chief.

Section 481, Revised Statutes, provides that the Commissioner of Patents shall "superintend *or perform* all duties respecting the granting and issuing of patents directed by law."

He has authority to take a case up and act upon it personally in the first instance, and without regard to any decision of an examiner. He not only has the authority, but it is his duty, to refuse it where he is of the opinion that the applicant is not "justly entitled to a patent under the law." (Section 4893, Revised Statutes.)

He is not simply an appellate tribunal, as contended by the plaintiff. This is made clear in the Whiteley case and in *Butterworth* v. *Hoe* (112 U. S., 50).

The plaintiff, furthermore, asked the Commissioner to act upon the question raised by the primary examiner, and therefore can not be heard to say that the action was of no effect. He can not be permitted to ignore that action. If it was a rejection, he has mistaken his remely, since he

should have appealed to the court of appeals from the Commissioner's decision instead of applying for a mandamus.

Plaintiff has admitted that the action of the primary examiner was not a rejection of a claim and not appealable.

When plaintiff asked the Commissioner to review the examiner's action, he did so by petition under rule 145 (par. 13, return, page 10, record), which rule provides for review of a question which "does not involve the merits of the invention claimed or *the rejection of a claim*." By that petition he clearly admitted the examiner's action did not involve a rejection of a claim.

Plaintiff acquiesced in the decision of the primary examiner and can not now object and appeal therefrom.

If the examiner's action was originally appealable, the plaintiff forfeited his right of appeal by his conduct.

He was notified by the examiner that he must acquiesce in the requirement for division before he would be entitled to an interference with a patent to Duncan (par. 8, return, p. 9, record). By his acceptance of the examiner's ruling the Patent Office was induced to declare and conduct the interference proceeding which the plaintiff could not otherwise have obtained. Since he accepted the decision and both parties acted under it, he can not now appeal from it, even if he could in the first instance.

No appeal from the ruling of the primary examiner to the examiners in chief was permissible in any view of the case.

It is clear that the examiner's action was not in the first instance appealable unless within the meaning of section 4909, Revised Statutes, which applies to an application "any of the claims of which have been twice rejected."

Rejection means an adverse ruling upon the merits and not a mere requirement as to form or procedure. In this case there has been no adverse ruling upon the merits by the primary examiner.

Under the general rule of law the examiner's action to be appealable must dispose of the whole case, and not merely require certain steps preliminary to an adjudication of the claim. As said in *Bostwick* v. *Brinkerhoff* (106 U. S., 3):

> If the judgment is not one which disposes of the whole case on its merits, it is not final. Consequently it has been uniformly held that a judgment of reversal with leave for further proceedings in the court below can not be brought here on writ of error.

It was made plain in *Butterworth* v. *Hoe* (112 U. S., 50) that every failure to issue a patent is not a rejection within the meaning of the law, since "It applies only when the Commissioner decides to reject an application for a patent on the ground that the applicant is not, *on the merits*, entitled to it."

The action must be a denial of the applicant's right to his claims and must be of such character

as to prevent him from securing those claims unless reversed on appeal.

It was clearly not the intention of Congress to make preliminary questions of form and procedure appealable under sections 4909, 4910, and 4911, Revised Statutes. The Commissioner of Patents by section 483, Revised Statutes, is given authority to make rules governing procedure. He is therefore unmistakably designated by the statutes as the final authority upon such matters, and action thereupon is not subject to appeal.

The first statute providing for appeal was that of 1836. (4 Stat. L., 577.) Section 7 of that act enumerated certain grounds of rejection relating to the merits, and provided for an appeal from a ruling holding the applicant was not entitled to a patent. Subsequent statutes relating to appeals have made no attempt to enumerate the grounds of rejection.

At the time of the passage of the act of 1870, the foundation of the present patent system, the following rule promulgated by Commissioner Fisher in 1869 was in force:

> 44. After an application for a patent has been twice rejected upon the merits by the examiner having it in charge, it may, at the option of the applicant, be brought before the board of examiners in chief on payment of a fee of ten dollars. For this purpose a petition in writing must be filed, signed by the party or his authorized agent or attorney.

The history of the legislation shows that the right of appeal was given to secure correct determination upon the merits of applications for, as said in *Butterworth* v. *Hoe* (*supra*, p. 60), it—

> * * * is not the exercise of ordinary jurisdiction at law or in equity on the part of that court, but is one step in the statutory proceeding under the patent laws whereby that tribunal is interposed in aid of the Patent Office, though not subject to it.

The court of appeals said in the present case:

> It is not denied that to constitute a rejection of the claims in the meaning of the statute the action * * * must amount in legal effect to an adverse decision in respect to the merits of the claim, and be of a character to defeat the right to a patent therefor, unless reversed on appeal.

This has been the uniform construction of the law by all tribunals that have considered it, and it is clearly the right one.

Merits not involved—

The ruling by the examiner in this case did not reach the merits, and is therefore not appealable. There has been no ruling by him that plaintiff is not on the merits entitled to every claim made. He has not required the relinquishment of any claim, but has merely required him to present them separately. This is a mere matter of procedure and it alone could be settled by the proposed appeal. A decision on such an

appeal would not determine whether plaintiff is to receive a patent upon any claim. Whether the examiner were sustained or reversed upon the matter of procedure, the case would have to go back to him for final action upon the merits. The question raised is, therefore, clearly not one that disposes of the entire case, but, as decided by the lower court, is a mere preliminary matter of procedure.

Division not merits—

Division is not required upon the ground that the patent covering two inventions, if granted, would be declared invalid. No question as to validity is involved, since the courts have never declared a patent invalid because of the joinder of distinct inventions. Division, therefore, involves no question of merits.

Commissioner Fisher, referring to decisions sustaining patents, said in 1869:

> The doctrine of both of these cases seems to be that while the rule which assigns distinct inventions to distinct patents is a proper one, and one which the Commissioner may properly enforce, yet, if the patent actually issue, the courts will sustain it. It is certainly nowhere asserted that it is the duty of the Commissioner to include two or more inventions in one patent, but it is evidently referred to his discretion. (*Ex parte Yale*, C. D., 1869, 110.)

About the same time this court held, in *Bennett* v. *Fowler* (8 Wall., 445):

> It is difficult, perhaps impossible, to lay down any general rule by which to determine when a given invention or improvements shall be embraced in one, two, or more patents. Some discretion must necessarily be left on this subject to the head of the Patent Office. It is often a nice and perplexing question.

In *ex parte Mefford* (C. D., 1883, 95; 25 O. G., 881), Commissioner Butterworth said:

> From the decisions of the courts prior to this time it is clear that a patent containing them all would not for that reason be held invalid. (*Hogg* v. *Emerson*, 6 Howard, 437; *Barrett* v. *Hall*, 1 Mason, C. C., 447; *Moody* v. *Fisk*, 2 Mason, 112; *Wyeth* v. *Stone*, 1 Story, 273.)
>
> But it does not follow because the courts would not hold the patent invalid that it is the duty of the Patent Office to allow the application in its present form.

These cases announce the construction of the law which has always been followed. (*Ex parte Fefel*, 57 O. G., 409; *Ex parte Everson*, 68 O. G., 1381; *Ex parte Burgess*, 64 O. G., 1759; *Ex parte Demeny*, 64 O. G., 1649.)

The reason for requiring division was thus stated by Commissioner Fisher in *Ex parte Yale* (*supra*):

> Another consideration, which is not less important, is found in the classification of the various subjects of invention and the

> assignment of the different classes to different examiners. This division of labor is absolutely essential to the prompt and thorough examination of applications. It is adopted to facilitate the transaction of the public business, and the inventor himself is directly and immediately benefited by a strict adherence to it. Any union of inventions in one patent that would seriously impair this classification ought not to be permitted. Besides the delay and increased difficulty in making the examination, if the patent covers devices which enter into two classes, the drawing, which is single, must be deposited in the portfolio of the one class and be wanting in the portfolio of the other. It may thus be overlooked in the examination of the next case.

In *Ex parte Everson* (*supra*), twenty-four years later, it was said:

> The office classification must be considered in determining the question whether process and apparatus may be joined in the same application. This question of classification is one of the highest importance, and unless the lines of classification are kept clear there is danger that the present patent system will fall to pieces of its own weight.

It is absolutely necessary that the question of division be controlled by the Commissioner in order that he may carry out the examination system which Congress has created. The problem of classification is a serious one where 25,000 patents are granted each year.

The requirement for division merely affects costs and not substantial rights. The question of costs is not appealable.

In no way has the Commissioner attempted to increase fees fixed by law. The plaintiff is put to some expense by a requirement for division, but this is true of every requirement as to procedure and does not distinguish the present one from others.

Substantial rights not affected—

The plaintiff claims the requirement for division and the issuance of two patents instead of one will cause confusion and embarrassment to the public; but that fact, if true, does not adversely affect his interests. To give him the right of appeal, the examiner's action must adversely affect his interests, and not merely embarrass a stranger. There will, however, be no more confusion than happens every day when a broad patent is granted dominating other patents in the same art—such, for instance, as the Bell telephone. There is no real conflict of rights in such cases.

It is further claimed that where there is doubt whether the invention is a process or an apparatus, applicant should be permitted to claim both in one application. This admits he is not entitled to both, and as he is entitled to only one, there is surely no substantial injury to him in requiring him to limit the case to one.

No substantial injury can result to an applicant by requiring him to include his claims in two patents instead of one, unless the claims are thereby rendered invalid. If process and apparatus claims are embodied in two patents instead of one, plaintiff claims the courts may hold one of those patents invalid. There is no suggestion that *both* will be declared invalid, but merely that *one* may be. The only ground upon which one may be declared invalid, is that it covers the same thing as the other. Two patents for the same thing are not permissible. If they do cover the same thing and one is sustained, the applicant has all possible protection. He is not entitled to duplicate claims in one patent any more than in two.

There is no danger of the court holding a patent upon a process covers the same thing as one upon apparatus. If the process claim is not independent of the apparatus, it is merely for the function of the apparatus and is invalid whether in the same case or a separate case. This is settled by many decisions of this court.

Process and apparatus independent—

It is a well-settled principle in patent law that a process and an apparatus are distinct, separable, and independent things. A process is the mode of treatment to produce a certain result, and as said in *Cochrane* v. *Deemer* (94 U. S., 780–788):

> It is an act or a series of acts performed upon the subject-matter to be transformed and reduced to a different state or thing—

whereas a machine is a combination of mechanical elements which may or may not be useful in performing the acts which constitute the process.

As was said in *Corning* v. *Burden* (15 How., 252–268):

> It is when the term process is used to represent the means or method of producing a result that it is patentable, and it will include all methods or means which are not effected by mechanism or mechanical combinations.

The court further pointed out that an alleged process which is the mere function of mechanism is not patentable.

James v. *Campbell* (104 U. S., 356–376):

> A patent for a process and a patent for an implement or a machine are very different things.

In *Heald* v. *Rice* (104 U. S., 736–753) this court said:

> A patent for a machine can not be reissued for the purpose of claiming the process of operating that class of machines, because if the claim for the process is anything more than for the use of the particular machine patented it is for a different invention.

If it is for the mere use of the machine, it is not patentable, because not a true process.

In *Tilghman* v. *Proctor et al.* (102 U. S., 707–728) it was said:

> It is very certain that the means need not be a machine or an apparatus. It may, as the court says, be a process. A machine is a thing. A process is an act or a mode of acting. The one is visible to the eye—an object of perpetual observation. The other is a conception of the mind, seen only by its effects when being executed or performed. Either may be the means of producing a useful result.

This court, in *Rubber Company* v. *Goodyear* (9 Wall., 788–796), said:

> Patentable subjects, as defined by the patent law, are "any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement on any art, machine, manufacture, or composition of matter." A machine may be new, and the product or manufacture proceeding from it may be old. In that case the former would be patentable and the latter not. The machine may be substantially old and the product new. In that event, the latter, and not the former, would be patentable. Both may be new, or both may be old. In the former case both would be patentable; in the latter, neither. The same remarks apply to processes and their results. Patentability may exist as to either, neither, or both, according to the fact of novelty, or the opposite. The patentability,

> or the issuing of a patent as to one, in no wise affects the rights of the inventor or discoverer in respect to the other. They are wholly disconnected and independent facts. Such is the sound and necessary construction of the statute.

Commissioner Mitchell, admitted by the plaintiff to be one of the ablest patent lawyers who ever held the office of Commissioner, said in the decision principally relied upon by plaintiff in this case:

> That process and apparatus constitute distinct inventions is too clear for argument, and it has been so decided over and over again by the Supreme Court of the United States. (*Ex parte Lord*, 50 O. G., 987, C. D., 1890, 16.)

If plaintiff should succeed in obtaining a decision that his process is absolutely dependent upon his mechanism, his process claims are not patentable because for the function of his mechanism.

Long established practice of Patent Office.—

An examination of the published decisions of the Patent Office (which extend from 1869 to date) fails to reveal any case in which the question of division has been treated as an appealable matter under sections 4909, 4910, and 4911, Revised Statutes. It has uniformly been held that it is a preliminary matter, left to the discretion of the Commissioner.

Rule 42 of the Patent Office provides that where an applicant is required to divide his case and limit it to one invention—

> If the independence of the inventions be clear, such limitation will be made before any action upon the merits; otherwise it may be made at any time before final action thereon.

There have been differences of opinion as to when division should be required, some holding that division should always be required between process and apparatus (*Ex parte Blythe*, 30 O. G., 1321; C. D., 1885, 82; *Ex parte Herr*, 41 O. G., 463; C. D., 1887, 105; *Ex parte Boucher*, 88 O. G., 545; and *Ex parte Frasch*, 91 O. G., 459), and others holding the question depended upon the circumstances of each case. There has never been a difference of opinion, however, upon the question whether division affects the merits and is an appealable matter.

Commissioner Mitchell had before him in the case of *Ex parte Chambers* (51 O. G., 1943; C. D., 1890, 101) the question whether an action by the primary examiner was appealable to the examiners in chief. He ruled the action was in effect a requirement for division and was not appealable, saying:

> The question of division has always been held to pertain to the administrative side of the functions of the Commissioner, and I am unable to understand how it becomes a

> question for the judicial cognizance of the successive tribunals of the office by being presented in the present form.

The only authority which plaintiff is able to cite in support of his contention, that the question of division is appealable to the examiners in chief, is the decision of Assistant Commissioner Fisher in *Ex parte Bellingrodt* (54 MS. Dec., 474), which was never published. In published decisions Assistant Commissioner Fisher and the then Commissioner, Mr. Seymour, announced a contrary practice. (*Ex parte Everson*, *Ex parte Demeny*, *supra*.)

It is interesting to note that even in the Bellingrodt case, aside from mere dictum, the ruling was that division was matter of form and not rejection. It was there said:

> The question of division therefore being one of form should be postponed, if the applicant is disposed to question the propriety of this requirement until after a final determination of the merits has been reached.

The uniform ruling of all Commissioners from the beginning has been that requirement for division is not appealable, and uniform and long-established construction of the statute by the able patent lawyers who have held the position of Commissioner is entitled to great weight. As was said in *Bate Refrigerating Company* v. *Sulzberger* (157 U. S., 1–34):

> If the statute be not so explicit as to preclude construction; if upon applying to it

> the established rules of interpretation; if looking at it in the light of previous legislation on the subject; if there be reasonable ground for adopting either one of two constructions, this court, without departing from sound principle, may well adopt that construction which is in harmony with the settled practice of the executive branch of the Government.

To adopt the construction contended for by plaintiff would upset the entire practice of the Patent Office, under which 50,000 applications for patents are disposed of each year, and cause great confusion. If one ruling as to procedure is appealable, all may be.

Last year the Commissioner decided 1,814 cases on interlocutory petition without fee, and 118 cases on appeal under section 4910, Revised Statutes. If rulings as to procedure are appealable, each of those cases should have come before him by appeal. The appeal fees alone would have amounted to $54,420.

The court of appeals in this case well said:

> These rules, with many others, forming a system of practical procedure for the Patent Office, were adopted by able, experienced patent lawyers who occupied the position of Commissioner of Patents, and they have been in force for many years and the practice of the Office has been made to conform to them. To support, at this late day, the contention of the appellant and declare these

rules in any material respect invalid upon the theory that they restrict the right of appeal, would be attended with very serious consequences to the Patent Office, indeed to the public. An established practice, such as has obtained under these rules, ought not to be disturbed by the court, except upon the clearest principle of right and necessity.

THE DEFENDANT IN ERROR RESPECTFULLY ASKS THAT THE WRIT OF ERROR BE DISMISSED FOR WANT OF JURISDICTION; AND IF THAT CAN NOT BE DONE, HE ASKS THAT THE JUDGMENT OF THE COURT OF APPEALS BE AFFIRMED.

J. C. MCREYNOLDS,
Assistant Attorney-General.

JOHN M. COIT,
Of Counsel.

WASHINGTON, *December 14, 1903.*

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